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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,893	04/16/2004	Kent S. Tarbutton	56847US007	2224

32692 7590 08/02/2006

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EXAMINER
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TO, TOAN C

ART UNIT	PAPER NUMBER
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3616

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/826,893	TARBUTTON ET AL.	
	Examiner	Art Unit	
	Toan C. To	3616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17, 19, 22-31 and 33-42 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 19, 22-24, 29 and 38 is/are allowed.
- 6) ☒ Claim(s) 25-28, 30, 31, 35, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 36, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Applicant's Request for Reconsideration*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

However, another final office Action sets forth below.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25-28, 30-31, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Joslin (U.S. 3,210,102).

Joslin discloses a frame comprising: a female tube portion (12) and a male tube portion (10), a portion of said female tube portion (12) being disposed about a portion of said male tube portion (10); a groove (16) disposed in at least one of said male tube portion (10) and said female tube portion (12) to form an annular region between said male tube portion and said female tube portion; and a cured adhesive (28) disposed in said annular region between said male tube portion and said female tube portion so as to form a bonded joint.

With respect to the recitation "the bonded joint capable of withstanding the hydroforming of said frame into a final form substantially without leakage and maintain sufficient strength, fatigue resistance and durability to be utilized within the frame", this

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recitation is considered as a functional recitation have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the frame of system of Joslin is considered to be capable of withstanding under hydroforming process.

With respect to recitation "hydroformed" in the preamble of claim 25, MPEP 2111.02 states that "If ... the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction", in this case, the recitation "hydroformed" is recited in the preamble for the intended use of the invention but does not limit the structure of the claimed invention; therefore, the recitation "hydroformed" in the preamble is considered of no significance to claim construction and have not been given any patentable weight.

With respect to recitation "permanently deformed by hydroforming so as to be reshaped into a different form" in claim 25, this recitation is considered as a process claimed limitation in a product claim, and MPEP 2113 states that

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Therefore, claim 25 is considered to be unpatentable over Joslin.

As to claims 26-28, Joslin discloses an frame as claimed, wherein said female tube (12) portion includes a remainder portion outside of said joint, said male tube portion (10) includes a remainder portion outside of said joint (see figure 2a), and the remainder portion of said male tube portion being disposed at an angle to the remainder portion of said female tube portion; and the remainder portion of the female tube (12) and the remainder portion of the male tube (10) form an L-shape (see figure 2a), wherein the groove is formed in the male tube portion (10), and the female tube portion does not contain a groove.

As to claim 35, Joslin discloses an frame, wherein said groove (16) has a groove depth, said male tube portion (10) and said female tube portion (12) have a fit-up clearance, and the ratio of the groove (16) depth to fit-up clearance is sufficient to prevent bypass leakage of said adhesive beyond said joint, when said adhesive (14) in an uncured state is disposed in said annular region.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 41-42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joslin in view of Emmons (U.S. 6,102,605)

Joslin discloses every element of the invention as discussed above except that the male and female tube portions are made of steel having a yield strength of 30kpsi to 50 kpsi or at least 50 kpsi.

Emmons teaches the tubular frames are made of steel having 120 kpsi yield strength. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the frame of Joslin by having his frame made of steel with 30kpsi to 50 kpsi or at least 50 kpsi in yield strength as taught by Emmons, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416.

### ***Response to Arguments***

6. Applicant's arguments filed July 17, 2006 have been fully considered but they are not persuasive. The prior art still read on the claimed limitations.

In response to applicant's argument regarding the rejection of the claims based upon Isaac et al, the rejection is hereby withdrawn for the reason that Isaac et al does not disclose a groove to form an annular region between the male tube portion and female tube portion.

In response to applicant's arguments that Joslin does not disclose the same frame structure as the frame recited in claim 25 because Joslin does not disclose his

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frame have been "permanently deformed", the examiner respectfully disagrees because, as mentioned above, Joslin discloses all the structure limitations as recited in claim 25 except that Joslin does not explicitly disclose his frame have been "permanently deformed", however "permanently deformed" is also considered as a part of method of making the frame into the final form.

In response to applicant's comment that "it would be improper for the next patent office action, if any, to be made final", the examiner respectfully disagrees because the previous rejection wasn't improper but instead it was a little unclear. This office action is rewritten from the previous final office action by applying the same prior art to reject the claims and adding explanations for clarification.

#### ***Allowable Subject Matter***

7. Claims 17, 19, 22-24, 29, and 38 are allowed.
8. Claims 36, and 39-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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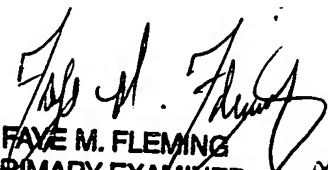
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan C. To whose telephone number is (571) 272-6677. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (571) 272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTo  
July 28, 2006

  
FAYE M. FLEMING  
PRIMARY EXAMINER 07/28/06